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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,054	01/15/2002	Etienne Georges Maze	003744-02	2937
7590	10/28/2004		EXAMINER	
Brenda L. Havel Metal Coatings International Inc. 275 Industrial Parkway Chardon, OH 44024			LAVILLA, MICHAEL E	
			ART UNIT	PAPER NUMBER
			1775	

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,054

Applicant(s)

MAZE ET AL.

Examiner

Michael La Villa

Art Unit

1775

[Handwritten signature]

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is not persuasive, but the finality of that action is withdrawn in view of the newly presented rejection under section 102(b) set forth below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:
3. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See the reasons of record in the Office Action mailed on 12 July 2004.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:
6. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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- I. Regarding Claims 1, 2, 4, and 6-8, it is unclear what is being admitted as the composition of the prior art. See the reasons of record in the Office Action mailed on 12 July 2004.
- II. Regarding Claims 1, 2, 4, and 6-8, it is unclear what is required by the references to "curing" and "cured". It is unclear whether the limitation "adapted for application to, and curing on" constitutes a compositional requirement, or not. Can a composition be adapted for application and curing without further requiring some compositional ingredient that cures? See the reasons of record in the Office Action mailed on 12 July 2004.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
 9. A person shall be entitled to a patent unless –
 - (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
 - (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
 - (f) he did not himself invent the subject matter sought to be patented.
10. Claims 1 and 5-8 are rejected under 35 U.S.C. 102(a or b or f) as being anticipated by Applicant's Admissions with respect to Eckart STAPA 4ZnAl7.
See the reasons of record in the Office Action mailed on 12 July 2004.

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11. Claims 2 and 3 are rejected under 35 U.S.C. 102(a or b or f) as being anticipated by Applicant's Admissions with respect to Eckart STAPA 4ZnSn30. See the reasons of record in the Office Action mailed on 12 July 2004.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaliardos USP 4,356,036 in view of Applicant's Admissions for the reasons of record in the Office Action mailed on 12 July 2004.

Response to Amendment

- I. In view of applicant's arguments, applicant traverses the section 112, first paragraph rejection of the Office Action mailed on 12 July 2004. Applicant cites a passage at pages 7 and 8 of the Specification in order

to demonstrate antecedent support. The cited passage specifies an amount of zinc that is not specified in Claim 7. It is unclear what is the basis for support for a broader claim that does not specify the amount of zinc. None of applicant's citations to "further support" at the conclusion of applicant's arguments discloses the entirety of the invention as now claimed in Claim 7. Only certain of the elements of Claim 7 appear to be taught in each citation. For example, original Claim 7 does not leave the amount of zinc unspecified.

- II. In view of applicant's arguments, applicant traverses the section 112, second paragraph rejection of the Office Action mailed on 12 July 2004. Applicant argues that there is no admission of prior art. However, the claim format appears to be that of Jepson format, in which, by convention, the preamble is admitted prior art. Applicant argues that the claims do not require a curing agent in the composition. However, applicant appears to say that the coating composition is to undergo curing. It is unclear what is the material that applicant considers applicant has claimed and that would be cured.
- III. Applicant has submitted a Declaration on 13 October 2004 by Inventors Dorsett and Guhde. The declaration provides supporting documentation for applicant's contention that the Eckart pastes that are the subject of the section 102 (a or f) rejections in the Office Action mailed on 12 July 2004 were derived from applicant's prior work. It

appears to be correct that inventors of the instant application were involved in preparing the pastes at issue. In paragraph 5 of the declaration, declarants state that the Eckart pastes at issue are mentioned in the provisional application. While the Zn/Al paste is observed to be mentioned, it is unclear where the Zn/Sn paste is mentioned. Paragraph 28 of the Declaration states that the Eckart pastes at issue were incorporated into the STAPA line of pastes upon Dacral "requesting and specifying the pastes from Eckart" and upon Eckart providing the pastes. It is understood that at least at the time that the pastes were incorporated into the "line of pastes" the pastes would be considered on sale in the United States. Eckart is described as providing pastes in paragraph 13. It is unclear what is the date of the referenced letter, but it may be 1996. Paragraph 16 appears to refer to testing of the paste materials on or prior to 7 February 2000. Paragraph 18 refers to a letter that is apparently not provided. Paragraph 19 is a letter from Eckart that appears to suggest that development of the pastes was considered a partnership arrangement among MCII, Dacral, and NDS, and Doral (affiliated with Eckart). Paragraph 20 describes a notebook in which the STAPA designation for the Zn/Al paste is used over the period 19 December 2000 through 19 January 2001. Paragraphs 24-27 describe purchase orders for STAPA pastes at issue in March 2001 and later. Which of these dates,

if any, represents the time of first sale in the United States is not clarified in the provided information. However, absent more specific information, the earliest dates, of either 1996 or earlier than 7 February 2000, in view of the language of paragraph 28, may be presumed to be the first on sale in the United States dates. Both of these dates precede the provisional filing date by more than one year. Applicant may choose to submit additional information in order to demonstrate that the first sale of the Zn/Al paste occurred within a year of the provisional filing date and that the first sale of the Zn/Sn paste occurred within a year of the application filing date.

- IV. In view of applicant's arguments and applicant's declaration, applicant traverses the section 102 (a or f) rejection over Applicant's Admissions with respect to the Eckart STAPA Zn/Al paste. Applicant argues that this paste is not prior art because it constitutes applicant's work. Applicant argues that the paste does not anticipate the claim because the claim is directed to a coating composition, as opposed to a paste, which is a component of a coating composition. The pastes comprise liquid and flake of the claimed alloy composition, and so rejection is appropriate. The relied upon claim language for distinguishing the paste from the composition is indefinite and hence the argument is not persuasive. Furthermore, while applicant may have contributed to developing the paste, it is unclear whether the inventive entity with

respect to the paste is the same as with respect to the composition containing the paste. In view of the characterization of the working relationship as a "partnership" for developing the paste and in view of the explanation that the claimed invention is not a paste but a composition containing a paste, it is not clear that the same inventive entity was involved in making the paste as was involved in the claimed invention. Rejection under section 102 (b) appears to be appropriate in view of the explanation of paragraph 28. It appears that the described activities may have involved on sale bar activities prior to one year before the provisional application filing date of 14 February 2001.

- V. In view of applicant's arguments and applicant's declaration, applicant traverses the section 102 (a or f) rejection over Applicant's Admissions with respect to the Eckart STAPA Zn/Sn paste. Applicant argues that this paste is not prior art because it constitutes applicant's work. Applicant argues that the paste does not anticipate the claim because the claim is directed to a coating composition, as opposed to a paste, which is a component of a coating composition. The pastes comprise liquid and flake of the claimed alloy composition, and so rejection is appropriate. The relied upon claim language for distinguishing the paste from the composition is indefinite and hence the argument is not persuasive. Furthermore, while applicant may have contributed to

developing the paste, it is unclear whether the inventive entity with respect to the paste is the same as with respect to the composition containing the paste. In view of the characterization of the working relationship as a "partnership" for developing the paste and in view of the explanation that the claimed invention is not a paste but a composition containing a paste, it is not clear that the same inventive entity was involved in making the paste as was involved in the claimed invention. Rejection under section 102 (b) appears to be appropriate in view of the explanation of paragraph 28. It appears that the described activities may have involved on sale bar activities prior to one year before the application filing date of 15 January 2002.

- VI. In view of applicant's arguments and applicant's declaration, applicant traverses the section 103 rejection over Kaliardos in view of Application's Admissions of the Office Action mailed on 12 July 2004. Applicant's reasons for traversal are addressed above in discussing the section 102 rejections and whether the Eckart STAPA Zn/Al paste is prior art.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (571) 272-1539. The examiner can normally be reached on Tuesday, Thursday, and alternating Fridays.

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16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael La Villa
26 October 2004

A handwritten signature in black ink, appearing to read 'La Villa', with a stylized flourish at the end.